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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/587,779

**Applicant(s)**

THELWELL, GORDON

**Examiner**

Joshua Rodden

**Art Unit**

3637

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 61-71, 74-83, 86 and 87 is/are pending in the application.
- 4a) Of the above claim(s) 89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-71, 74-83, 86 and 87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-60, 72, 73, 84, 85 and 88 have been cancelled. New Claim 89 has been added.

#### ***Specification***

1. The Amendment to the specification was received on 02/28/11. This Amendment to the specification is acceptable and has been entered.

The disclosure is objected to under 37 CFR 1.74 because of the following: reference character '604' has been used to denote both "a first connecting side member" and "a first connecting member"; reference character '607' has been used to denote both "a second inner side member" and "a second connecting member"; reference character '608' has been used to denote both "a second connecting side member" and "a second inner side member".

Appropriate correction is required.

#### ***Claim Objections***

2. Claims 61 and 89 are objected to because of the following informalities: Claims 61 and 89, the phrase "front face" should be "front member." Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 61-71, 74-83, 86, 87 and 89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 61 recites "a substantially rectangular front portion consisting of a front member, first and second outer side members, first and second inner side members..." However, the "substantially rectangular front portion" only appears to consist of the "front member" and the "first and second outer side members." For purposes of examination, it is assumed that the phrase "a substantially rectangular front portion consisting of a front member, first and second outer side members, first and second inner side members..." is meant to state "a substantially rectangular front portion consisting of a front member, and first and second outer side members, the column further having first and second inner side members... Applicant may wish to amend the language of claim 61 accordingly.

Claim 61 recites "such that the outer shell is coupled to and received by the first and second side members." However, it is not clear as to what is attempting to be claimed with the terms "coupled to" and "received by". The specification does not appear clear and complete as to "the outer shell is coupled to and received by the first and second side members." For example, the "inner side edges" do not appear to contact the "outer shell" as is seen in Figure 6.

Claim 61 recites "for the liner to encapsulate the front face and portions of the first and second inner side member of said upright column." However, the

Art Unit: 3637

"liner" does not appear to "encapsulate" the "first and second inner side member." For purposes of examination, it has been assumed that the phrase "inner side member" is supposed to recite "outer side member" as this is what is recited in claim 89.

Claim 89 recites "a substantially rectangular front portion consisting of a front member, first and second outer side members, first and second inner side members..." However, the "substantially rectangular front portion" only appears to consist of the "front member" and the "first and second outer side members." For purposes of examination, it is assumed that the phrase "a substantially rectangular front portion consisting of a front member, first and second outer side members, first and second inner side members..." is meant to state "a substantially rectangular front portion consisting of a front member, and first and second outer side members, the column further having first and second inner side members... Applicant may wish to amend the language of claim 89 accordingly.

Claim 89 recites "such that the outer shell is coupled to the first and second side members." However, it is not clear as to what is attempting to be claimed with the term "coupled to". The specification does not appear clear and complete as to "the outer shell is coupled to the first and second side members." For example, the "inner side edges" do not appear to contact the "outer shell" as is seen in Figure 6.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claim 61-69, 71, 74-83, 86 and 87 rejected under 35 U.S.C. 103(a) as being unpatentable over U.K. Patent Application GB 2,321,688 A (Ian) in view of U.S. Patent No. 6,684,572 (Homolka et al.).**

Regarding **Claims 61-64, 80-83, 86 and 87**, Ian teaches; **Claim 61** - a column protecting device (3) for protection of an upright column (9 – wherein it should be understood that the “upright column” is only recited in claim 61 and its dependent claims in terms of the intended use of the “column protector”, and thus the prior art “column protector” of Ian only needs to be capable of performing the intended use, and thus Ian is not required to teach all of the specifics of the “upright column”; Therefore, the “upright column” in this rejection is only detailed in order to detail the functionality of the “column protector” of Ian

Art Unit: 3637

in regards to the intended use language of the claims, Also See "Response to Arguments Section" Below) of a racking system, (Figure 3); wherein the column (9) has a channel shaped cross section (AA) having a substantially rectangular front portion (BB) consisting of a front member (CC), first and second outer side members (DD and EE), first and second inner side members (FF), first and second connecting members connecting the first and second outer side members (DD and EE) to the first and second inner side members (FF), respectively, (Annotated Figure 2 Below); a first outer lip member (one of two outer lips being shown as (ZZ)) extending outwardly from an outer edge of the first inner side member (FF) and extending in a plane substantially parallel to the front member (CC), and a second outer lip member (ZZ) extending outwardly from an outer edge of the second inner side member (FF) and extending in a plane substantially parallel to the front member (CC), (Annotated Figure 2 Below); the column protector device (3) being arranged to clip onto the upright column (9), (Figure 2 and Page 4, Lines 10-14); the protector device further comprises a rigid part cylindrical "C" shaped cross section outer shell (3), and an inner liner (1 and 2) shaped to fit within the outer shell (3), (Figure 2 and Page 3, Lines 3-8 of the specification); wherein the outer shell (3) is capable of fitting around the upright column (9) so that the outer shell (3) retains to the column (9) without further fixtures, (Figure 2 and Page 4, Lines 10-14); the outer shell (3) also surrounds the front member (CC), the first and second outer side members (DD and EE), and the first and second connecting members, such that the outer shell (3) is coupled to and received by the first and second inner side members

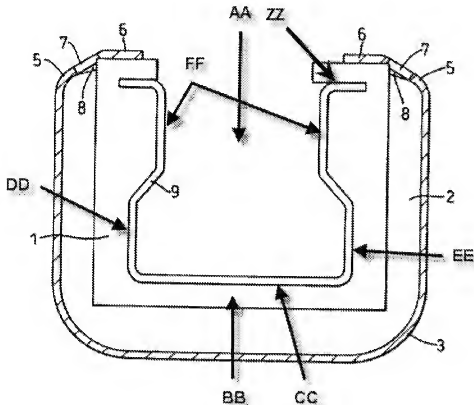
Art Unit: 3637

(FF) of the upright column (9), (Annotated Figure 2 Below, wherein it should be understood that the outer shell (3) would be functionally "capable of" having the end portions of the outer shelf (3) being "received" by the inner side members (FF) if the outer shell (3) was placed over a different size or shaped column (9) such as a column (9) having portions (ZZ) having extensions which wrap around the end portions (6) of the outer shell (3), Also See "Response to Arguments Section" Below); the inner liner (1 and 2) being retained between the outer shell (3) and the column (9), (Figure 3); the inner liner (1 and 2) comprises a solid substantially part cylindrical member having a substantially part cylindrical outer surface (the outer corners of (2) are rounded and the inner liner is therefore part cylindrical), the inner liner (1 and 2) also having a substantially "U" shaped channel (the inner surface of the liner (1) touching the upright column (9)) formed on an opposite side of said inner liner to said substantially part cylindrical outer surface and in which, in use, said channel provides for a flush interface between the inner liner (1 and 2) and the upright column (9), (as seen in Figure 2); **Claim 62** – the outer shell (3) being capable of partially surrounding the first and second inner side members (FF – wherein it should be understood that the outer shell (3) would be functionally "capable of" only partially surrounding the inner side members (FF) if the outer shell (3) was placed over a different size or shaped column (9) such as a column (9) having portions (ZZ) having extensions which wrap around the end portions (6) of the outer shell (3), See "Response to Arguments Section" Below) so that the exposed upright edges (the end edges near item (6) in Annotated Figure 2) of the outer shell (3) lay adjacent to the

Art Unit: 3637

sides of the column (9) at a position where the column (9) is relatively narrower, (Annotated Figure 2 Below); **Claim 63** – wherein, in use, the column (9) resides partially within a channel formed by the outer shell (3), (Figure 2); **Claim 64** – wherein said outer shell (3) comprises an elongate member having a substantially “C” shaped cross section, (Figure 2); **Claim 80** – wherein said inner liner (1 and 2) is capable of, after receiving an impact, the inner liner (1 and 2) promotes the repositioning of the whole device to an original shape before the impact occurred, (Figure 2 and Page 4, Lines 3-8); **Claim 81** - the outer shell (3) surrounding the front member (CC) and being capable of partially surrounding the first and second inner side members (FF – wherein it should be understood that the outer shell (3) would be functionally “capable of” only partially surrounding the inner side members (FF) if the outer shell (3) was placed over a different size or shaped column (9) such as a column (9) having portions (ZZ) which wrap around the end portions (6) of the outer shell (3), See “Response to Arguments Section” Below), and also surrounding the inner liner (1 and 2), which rests between a substantially part cylindrical inner surface of the outer shell (3) and an outer face of the front member (CC), an outer face of the first outer side member (DD) and second outer side member (EE), (Annotated Figure 2 Below); **Claim 82** - the inner liner and outer shell being slideable with respect to each other along a central axis of the outer shell, (Page 1, Lines 24-28); **Claim 83** - the outer liner and an inner liner being bonded together, (Page 2, Lines 1-5); **Claim 86** - the outer shell and the inner liner composed of polycarbonate and foam (Page 2, Line 8 and Page 2, Lines 6-7); both materials having greater ductility,

and impact resilience then the shelving which is made from metal (Page 1, Lines 12-14); **Claim 87** - teaches the device being "capable of" fitting around the upright column so that the outer shell (3) retains to the column (9) without further fixtures, (Figure 2 and Page 4, Lines 10-15).



**Annotated Figure 2**

**Ian** does not teach: wherein the outer shell is substantially cylindrical with a substantially "C" shaped cross section (**Claim 61**). However, **Homolka et al.** teaches: **Claim 61** – an outer shell (8) which is substantially cylindrical with a substantially "C" shaped cross section, (Figures 1-5). Therefore, it would have been obvious to one of ordinary skill in the art to modify the outer shell of the

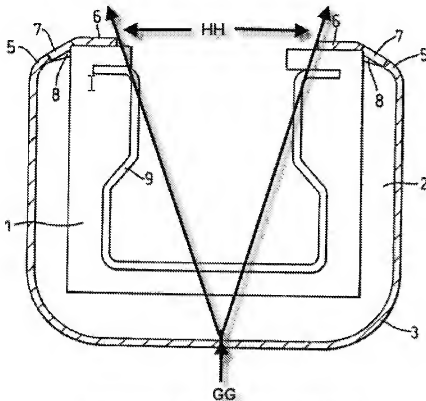
Art Unit: 3637

column protector of **lan** to have wherein the outer shell is substantially cylindrical with a substantially "C" shaped cross section (**Claim 61**) as taught by **Homolka et al.** for the purposes of having a shape which has no sharp corners which allows for a safer device which also is more efficient at deflecting impact forces. Additionally, it should be understood that it is extremely well known in the art to make bumpers and Column guards cylindrical in cross section as is evidenced by: U.S. Patents No. 1,620,933 (Wilcox), No. 3,372,552 (Liddel), No. 4,113,110 (Mittag), No. 5,482,238 (Kreiter), No. 6,102,611 (Roller) and No. 6,242,070 (Gillispie et al.).

Regarding **Claim 65, lan as modified by Homolka et al.** teaches the column protector as described above (See Rejection of Claim 61 Above), in addition to **lan** teaching the outer shell (3) comprising a tubular substantially cylindrical member (3), (Figure 3); wherein the tube has a pair of substantially parallel opposing edges (the end edges near item (6) in Annotated Figure 2, Version #2 Below) on either side of a gap, (Figure 2). **lan as modified by Homolka et al.** does not teach the cylindrical member extending over an angle in the range of 260 to 280 degrees, but **lan** does teach a range (HH) about a longitudinal centre line (GG) of the outer shell (3) which is very similar to the claimed range, (Annotated Figure 2, Version #2 Below). Therefore, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed

Art Unit: 3637

dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). It would have been obvious to one of ordinary skill in the art to modify the prior art device of **Ian as modified by Homolka et al.** to have the cylindrical member extending over an angle in the range of 260 to 280 degrees for the purpose of user design as it would not cause the device to perform differently.



Annotated Figure 2, Version #2 (Jan)

Regarding **Claims 66-68, Ian as modified by Homolka et al.** teaches the limitations discussed above, in addition to teaching various dimensional aspects of the claimed invention. **Ian as modified by Homolka et al.** does not teach the exact dimensional aspects as recited in claims 66-68. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ

Art Unit: 3637

777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the column protector of **lan as modified by Homolka et al.** with a height between 30-120cm, or an external diameter of 10-14cm or an outer wall thickness between 7-9mm since the column protector of **lan as modified by Homolka et al.** would not perform differently than it would before with its previous dimensions.

Regarding to **Claim 69, lan as modified by Homolka et al.** teaches the limitations as discussed above, in addition to **lan** teaching a pair of opposing edges (6) spaced apart from one another at a given distance, (Figure 2). **lan as modified by Homolka et al.** does not teach that given distance being between 5cm and 11cm. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the

Art Unit: 3637

distance between the opposing edges of **lan as modified by Homolka et al.** to be between 5cm and 11cm as this would not affect the functioning of the device of **lan as modified by Homolka et al.**

Regarding **Claim 71, lan as modified by Homolka et al.** teaches the column protector as described above (See Rejection of Claim 61 Above), in addition to **lan** teaching the outer shell being made from polycarbonate, (Page 2, Line 8). It should also be understood that the following materials are all well known in the art as substitutions for polycarbonate: resilient elastomeric polymer based materials; polyethylene; high density polyethylene; polypropylene; polyvinylchloride; polystyrene; plastic; or a mixture of plastics.

Regarding **Claim 74, lan as modified by Homolka et al.** teaches the limitations as discussed above, in addition to **lan** teaching the outer surface of the substantially U shaped channel of the inner liner (the inner surface of (1)) being separated a given distance from outer part cylindrical surface (outer surface of liner (2)), (Figure 2). **lan as modified by Homolka** does not teach the given dimensions being in the range of 2 to 5cm. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently then the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

Art Unit: 3637

invention to provide the column protector of **lan as modified by Homolka et al.** with a distance between the outer part cylindrical surface and the outer surface of the U-shaped channel between 2-5cm since the column protector of **lan as modified by Homolka et al.** would operate equally the same with any desired dimensions.

Regarding **Claim 75, lan as modified by Homolka et al.** teaches the limitations as discussed above, in addition to **lan** teaching the inner liner being made from a compressive composite material, (Figure 2 and Page 2, Lines 1-7). Wherein, it should be understood that the Examiner takes OFFICIAL NOTICE that the following materials are all well known in the art as substitutions for a compressive composite material: polyethylene; polypropylene; polycarbonate; polyvinylchloride; polystyrene; natural rubber foam; synthetic rubber foam; closed cell SBR foam material.

Regarding **Claims 76 and 77, lan as modified by Homolka et al.** teaches the limitations discussed above, in addition to **lan** teaching various dimensional aspects of the claimed invention. **lan as modified by Homolka et al.** does not teach the exact dimensional aspects as recited in claims 76 and 77. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device

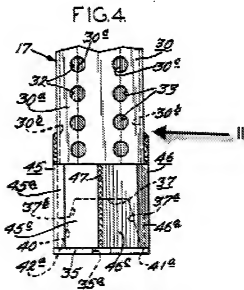
Art Unit: 3637

(See MPEP 2144). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the inner liner of **lan as modified by Homolka et al.** with a height between 30-120cm, or an external diameter of 10-14cm since the column protector of **lan as modified by Homolka et al.** would operate the same with any desired dimensions.

Regarding **Claims 78 and 79, lan as modified by Homolka et al.** teaches the limitations as discussed above, in addition to **lan** teaching the inner liner (1 and 2) being U-shaped and having a given width and depth dimension, (Figures 1(a) and 1(b)). **lan as modified by Homolka et al.** does not teach the exact dimensional aspects of the width and depth dimensions as recited in claims 78 and 79. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently then the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide "U" shaped channel of the inner liner of **lan as modified by Homolka et al.** with width in the range of 7 to 12 cm, or a depth in the range of 2 to 4cm since the column protector of **lan as modified by Homolka et al.** would operate the same with any desired dimensions.

8. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.K. Patent Application GB 2,321,688 A (Ian) in view of U.S. Patent No. 6,684,572 (Homolka et al.), and further in view of U.S. Patent No. 4,088,229 (Jacoby et al.).

Regarding Claim 70, Ian as modified by Homolka et al. teaches the limitations discussed above, but does not teach the outer shell having a chamfered edge. However, Jacoby et al. teaches a shell of a protector having a chamfered edge (II) between its outer and inner surface, (Annotated Figure 4 Below). Therefore, it would have been obvious to one of ordinary skill in the art to modify Ian as modified by Homolka et al. to have the outer shell with chamfered edges as taught by Jacoby et al. for the purpose of user efficiency and improved protection of the upright column.



Annotated Figure 4

***Response to Arguments***

9. Applicant's arguments filed 02/28/11 have been fully considered but they are not persuasive.

10. The applicant argues:

*"According to Ian, the outer shell does not couple to the pallet rack column at all. The outer shell surrounds the entire column, including the outer lip members. Furthermore, the inner liner also surrounds the entire pallet rack column. Thus, Ian cannot be read to teach or otherwise suggest "said outer shell surrounds the front member, the first and second outer side members, and the first and second connecting members, such that the outer shell is coupled to and received by the first and second inner side members of the upright column, thereby protecting the front member, the first and second outer side members, the first and second connecting members and parts of the first and second inner side members." (See Pages 14 and 15 of Applicant's Arguments)*

However, the Examiner disagrees. The outer shell is certainly "coupled" to the pallet rack column (9) as is described in the rejections of the claims above. Furthermore, if the Applicant is attempting to imply that the outer shell "contacts" the pallet rack column; Figure 6 of Applicant's own invention shows that the outer shell (300) does not "contact" the pallet rack column (601). Finally, it should be understood that the "upright column" of claims 61-71, 74-83, 86 and 87 is only claimed in an intended use format, wherein a recitation of the intended use of

Art Unit: 3637

the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this instance, the column protector of Ian as modified by Homolka et al. and Jacoby is certainly capable of performing the intended use/functional language upon a pallet rack column meeting the structural features as described in regards to the "upright column" of claims 61-71, 74-83, 86 and 87.

11. The applicant argues:

*"Applicants respectfully submit that Homolka does not cure the deficiencies of Ian. Homolka is directed towards a jamb protector. A jamb does not have a cross-sectional shape disclosed above. As such, Homolka does not teach "said outer shell...inner side members." (See Page 15 of Applicant's arguments)*

However, the Examiner disagrees. The Examiner notes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this instance, Homolka teaches that it is well known to have the outer surfaces of impact protecting devices being tubular or rounded in shape, and thus one of ordinary skill in the art would have recognized that the

Art Unit: 3637

outer shell of Ian could be modified to be tubular or rounded in shape.

Additionally, it has been noted that the following patents also suggest to one of ordinary skill in the art that the outer shell of Ian could be modified to be tubular or rounded in shape: U.S. Patents No. 1,620,933 (Wilcox), No. 3,372,552 (Liddel), No. 4,113,110 (Mittag), No. 5,482,238 (Kreiter), No. 6,102,611 (Roller) and No. 6,242,070 (Gillispie et al.).

12. The applicant argues:

*"Jacoby is directed to a rack. Applicant submits that Jacoby cannot cure the deficiencies of Ian and Homolka as applied to claim 61." (See Page 16 of Applicant's Arguments)*

However, the Examiner states that there are no deficiencies in regards to the rejection of claim 61 in view of Ian and Homolka as is explained above.

### **Conclusion**

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

Art Unit: 3637

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Josh Rodden whose telephone number is (571) 270-5222. The examiner can normally be reached on M-Th 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darnell Jayne can be reached on (571) 272-7723. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/MICHAEL SAFAVI/  
Primary Examiner, Art Unit 3637

/Joshua Rodden/  
Art Unit: 3637